

REMARKS

a. Amendments to Claims

The Response to a Made Final Rejection is limited to making amendments to the claims so as to advance prosecution without requiring a new search, to crystallize the issues for the appeal, and to address specific misunderstandings. The undersigned thanks the Examiner for withdrawing the objections to the drawings and the abstract as well as the 35 U.S.C. § 112 rejections. The applicant herein incorporates all prior arguments with respect to Adams, but subject to the limitation of arguments in this Response seeks to advance prosecution as follows.

Amendments to independent claims 1, 2, 10, 11 and 16 have been made to clarify that the slot machine (claims 1, 2 and 10) or casino game (claims 11 and 16), in the preamble is played "to a spin outcome." While this was already stated in each independent claim, this clarifies that the method of the present invention provides method steps pertaining only to this one spin outcome. No new search is required as "a spin outcome" already was claimed in each independent claim. The remaining amendments are made to provide proper antecedents. No new search is required. These amendments positively clarify that the method of play of the claimed invention is directed to (1) the random appearance of the trigger symbol in the symbols of the "said spin outcome" and (2) the selection of another symbol by the player in "said spin outcome" when trigger symbol appears. Again, these are clarifying amendments as both features were presented in each independent claim. Hence, no new search is required.

b. Misunderstanding

The rejection appears to misstate the teachings of Adams:

"Adams discloses a video embodiment of the well-known game of Joker Poker. In Joker Poker, the player is presented with a display of symbols that is a result of the spin outcome (FIG 1). The player can hold all cards or choose to replace them with other cards. When a trigger of having a reserved wild card occurs, the system lets the player select and replace a displayed symbol with the wild joker (Column 4). When the player chooses to use their wild card, the symbol it replaces is now a wild symbol and the player is awarded in accord with a payable based on the result of the hand including the changed wild card (Column 5, lines 3-7)." (emphasis added)

Adams actually teaches a "traveling" wild card for use on a game subsequently played after the first game (see entire specification and claim 1). When a player has (1) received a wild card in the first game outcome, Adams (2) then requires the player either to play the wild card or to

press the "Reserve Wild Card" button 32 (Figure 2) (column 4, line 50). This then (3) places an image of a wild card in a separate reserve area 34 (Figure 2) (column 4, line 52). The player must then (4) wager (column 4, line 34) in a subsequent game (a second game) to (5) receive a second game outcome (Figure 2 and column 5, lines 3-8). The player then selects (6) any one card from among displayed cards in the second game outcome to replace with the reserved wild card (column 5, lines 3-8). The aforesaid six separate steps of Adams involving at least two separate game outcomes do not render obvious the method claimed herein of a single game with its single spin outcome of the claimed invention. The aforesaid claim amendments are made to clarify this.

The only disclosure in Adams relevant to the claimed invention of a single game and its single game outcome is where the player receives a wild card and uses it in the first game and that disclosure is conventional (column 2, line 34). The appearance of a wild card in Joker Poker (and in other old card games) is well known as discussed in the Background of the present application. The claimed invention represents a novel, non-obvious improvement over such conventional play.

Claim 1 originally recited "a spin outcome," but has been amended to place "a spin outcome" in the preamble as the present invention pertains to a single spin. Hence, the amendment clarifies what originally was stated. Adams requires receiving a wild card (which is reserved) in a first game and using the wild card in a subsequent second game. This is not the present invention as claimed. Nor, would it have been obvious to implement Adams' own teachings into a single game, as Adams specifically discloses a conventional use of the wild card in the first game. Hence, Adams actually teaches away from the present invention by requiring a player to place a wager to play at least one more game in which to use the reserved wild card. Indeed, the term "reserve" has no meaning in the present invention.

Further, claim 1, requires "when at least one trigger symbol randomly appears in said matrix of symbols in said spin outcome." The trigger symbol is illustrated in Figure 2 and is a symbol actually appearing in the spin outcome. It is a trigger symbol, not an Adam's wild card. As taught in the present specification on page 8, last paragraph, in one embodiment, the trigger symbol automatically becomes wild and, in another embodiment (page 9 second full paragraph) it does not become wild. (line 17) Claim 1 is not limited to either embodiment.

The misunderstanding is emphasized in the above quote in the Rejection, there is no appearance of a "trigger symbol" in the play outcome in Adams whatsoever. Nor, is there any teaching in Adams that the trigger symbols in Adams randomly appears. It is true that in the first game Adams receives a random wild card, but this is not a random trigger symbol under the teachings of the present invention, that can be played in the game outcome of the first game of Adams! In claim 1, the player in response to the appearance of the random trigger symbol, selects at least one of the other displayed symbols in the spin outcome. Of course, this simply does not occur in Adams as when the player receives a wild card in the first game, the player either accepts the wild card for play in the first game or reserves it for a subsequent game. There is virtually no teachings in Adams, whatsoever, of a player affecting any of the other symbols in the first game outcome! Hence, claim 1 is patentably distinct and non-obvious over Adams.

The Examiner's statement that "when a trigger of having a reserve wild card occurs, the system lets the player select and replace the displayed symbol with the wild joker" in the above quotation is believed to be a misunderstanding. The reserved wild card in a separate area of Adams (not in the game outcome) of Adams is not a random trigger displayed in the second game. It is not random as it was previously reserved by the player and is constant in its appearance and ability to be used in each subsequent game thereafter for a predetermined number of games in Adams. Further, the reserved wild card does not appear in the second game's play outcome (claim 1 the trigger symbol appears in the play outcome). Hence, there is no disclosure, suggestion, inference nor would it have been obvious to one skilled in the art to arrive at the applicant's invention as forth in claim 1 over Adams.

All of the remaining independent claims (and their dependent claims) have the same limitations as discussed above with respect to claim 1.

It is maintained, that the operation of Adams has been misunderstood and applied erroneously to the claimed invention.

Because the After Final Response, of necessity, is limited, each and every rejection set forth by the Examiner is not addressed and the arguments set forth before are specifically incorporated by reference with respect to each independent claim and each dependent claim. The applicant does not waive his rights due to the limited response nature of an "after final response."

Should you have any questions regarding the above, please feel free to give the below-listed attorney a call. If additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

DORR, CARSON, SLOAN, BIRNEY & KRAMER, P.C.

Date: 8/25/04

By: Robert C Dorr
Robert C. Dorr
Reg. No. 27,782
3010 East 6th Avenue
Denver, Colorado 80206
(303) 333-3010

C:\DOCS\Patent\Mikohn\357 - Response to 06-30-2004 OA